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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,360	03/06/2001	J. Ronald Wilk	P-121944.00002.001	3309

7590 05/29/2003

Jackson Walker  
112 E. Pecan Street, Suite 2100  
San Antonio, TX 78205

EXAMINER
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BADIO, BARBARA P

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 05/29/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/800,360

Applicant(s)

WILK, J. RONALD

Examiner

Barbara P. Badio, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**First Office Action on the Merits**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 112***

2. Claims 1-4, 6-16, 18-22 and 24-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The instant claims recite a solution containing "cedar leaf oil comprising from about 6% to about 10% by weight". The present specification lacks support for the recitation of the specific range of cedar leaf oil recited by the claimed invention. Thus, it does not convey to the skilled artisan that applicant, at the time the application was filed, had possession of the presently claimed invention.

It is noted that the present specification recites "the solution is approximately 10% cedar leaf oil by weight" and "the cedar leaf oil may comprise from about 8% to about 10% of the total weight of the solution" (see page 2, section 0006 and page 6, section 0021).

***Claim Rejections - 35 USC § 103***

**3. The rejection of claims 1-42 under 35 USC 103(a) over Nesbit ('403) in view of Warren et al. ('583) is maintained.**

Applicant argues (a) the list of antimicrobial agents taught by Warren is extensive and there is no indication that the use of cedar leaf oil is critical and (b) in light of the claimed ranges, Warren teaches away from the use of cedar leaf oil. Applicant's argument was considered but not persuasive for the following reasons.

It is noted that applicant's argument is centered on the Warren reference. However, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

As stated in the previous Office Action, Nesbit teaches the use of a topical composition comprising zinc oxide and other ingredients such as calamine and preservatives such as antibacterial and antiviral agents. Warren teaches a number of antibacterial agents including cedar leaf oil. The addition of antibacterial agents such as cedar leaf oil would be obvious to the skilled artisan based on the teaching by Nesbit that antibacterial agents preserve the composition by removal of any bacteria not removed during sterilization.

The examiner agrees that Warren teaches an extensive list of antimicrobial agents and does not indicate the criticality of cedar leaf oil. Applicant has not provided

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evidence of record showing some unexpected and unobvious property possessed by cedar leaf oil versus other antimicrobial agents.

The declaration of Dr. Wilk showing the effect of the claimed invention is noted. However, the declaration lacks comparison between said composition comprising cedar leaf oil and the same composition comprising another antimicrobial agent such as tea tree oil. In the absence of evidence showing some unexpected property of cedar leaf oil not possessed by other antibacterial agents, it is the examiner's position that the utilization of any antimicrobial agent, such as those taught by Warren, in the composition of Nesbit would be obvious to the skilled artisan based on the level of skill of the ordinary artisan and the teachings of the prior art.

Applicant also argues Warren teaches away from the use of the amount of cedar leaf oil recited by the instant composition. As indicated above, one cannot show nonobviousness by attacking references individually where the rejection is based on combination of references. Warren was combined with Nesbit for its teaching of cedar leaf oil as an antibacterial agents. As stated in the previous Office Action, the determination of the amount of antibacterial agents utilized in the composition taught by Nesbit would require only routine experimentation that is within the level of skill of the ordinary artisan in the art.

For these reasons and those given in Paper No. 5, the rejection of claims 1-42 under 35 USC 103(a) over Nesbit ('403) in view of Warren et al. ('583) is maintained.

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4. The rejection of claims 1-42 under 35 USC 103(a) over Oliver ('062) in view of Warren et al. ('583) is withdrawn.

***Other Matters***

5. Claim 17 is a duplicate of claim 23. Cancellation of one of said claims is requested.

***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


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***Telephone Inquiry***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P. Badio, Ph.D. whose telephone number is 703-308-4595. The examiner can normally be reached on M-F from 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on 703-308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

  
Barbara P. Badio, Ph.D.  
Primary Examiner  
Art Unit 1616

BB  
May 27, 2003